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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,947	10/27/2000	Kiichiro Sakashita	198801US3	6701

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EXAMINER
KEITH, JACK W

ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 07/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/696,947	Sakashita et al
Examiner	**Art Unit**
Jack K ith	3641

-- The MAILING DATE of this communicati n appears on the cover sheet with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Apr 25, 2002

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-12 is/are pending in the applica

4a) Of the above, claim(s) 5-12 is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-4 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 & 5
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of invention I, species A, a and i in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the examiner has not sufficiently demonstrated why the groups designated are considered to patentably distinct or that the species elections are necessary. Applicant's arguments are not persuasive. The examiner has set forth in the previous Office action how and in what manner the groups are considered to be separate and patentably distinct. I regard to the separate election of species applicant presents an invention with an abundant amount of species. Such is evident by the specification and claims. Clearly such constitutes a burden on the examiner to find each and everyone of applicant's embodiments.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 5-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions/species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Diersch et al (FR 2751118).

Diersch discloses applicant's inventive concept. An absorbing rod comprised of aluminum and boron having the same columnar shape of a control rod for a PWR is inserted into a guide tube of a fuel element prior to the assembly being transported. See entire document.

Note that statements of intended use, field of use, or "which is to be to" clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller et al (EP 0 372 551).

Mueller discloses applicant's inventive concept. An absorbing rod comprised of neutron absorbing material having the same columnar shape of a control rod for a PWR is inserted into a guide tube of a fuel element prior to the assembly being transported. See entire document.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Diersch et al (FR `275) as applied to claims 1 and 3-4 above, and further in view of Mueller et al (EP `551).

Diersch discloses applicant's inventive concept; however, it if not apparent that Diersch is capable of providing fixed absorbing rods at a position corresponding to a control rod guide pipe then Mueller teaches the fixing of absorber rods in place [fuel assembly] so as to prevent their removal.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the absorber rod fixing teaching of Mueller into the

absorber rod of Diersch, to gain the advantages thereof (i.e., prevent removal), as such results are in no more than the use of conventionally known designs/techniques within the fuel assembly storage art.

8. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diersch et al (FR `275) and further in view of Halverson et al (4,605,440).

Diersch discloses applicant's inventive concept as set forth above; however, if not apparent that Diersch discloses the use of aluminum composite as a neutron absorbing material then Halverson teaches the use of aluminum composite material in the same field of endeavor for the purpose of neutron absorption.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the aluminum composite material teaching of Halverson into the absorber rod of Diersch, to gain the advantages thereof (i.e., tough, lightweight, etc.), as such results are in no more than the use of conventionally known designs/techniques within the neutron absorption art.

9. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al (EP `551) and further in view of Halverson et al (`440).

Mueller discloses applicant's inventive concept as set forth above; however, Mueller does not discloses the use of aluminum composite as a neutron absorbing material.

Halverson teaches the use of aluminum composite material in the same field of endeavor for the purpose of neutron absorption.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the aluminum composite material teaching of Halverson into the absorber rod of Mueller, to gain the advantages thereof (i.e., tough, lightweight, etc.), as such results are in no more than the use of conventionally known designs/techniques within the neutron absorption art.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Keith whose telephone number is (703) 306-5752. The examiner can normally be reached on Monday through Friday from 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

jwk

July 3, 2002

MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER